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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,653	09/12/2000	Paul Henry Fuoss	IDS 1999-0541	6961

7590 03/26/2004

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EXAMINER

YUN, EUGENE

ART UNIT	PAPER NUMBER
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2682

10

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/659,653

**Applicant(s)**

FUOSS ET AL.

**Examiner**

Eugene Yun

**Art Unit**

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims <sup>1-4, 13, 15-18</sup>~~1-6, 9, 15 and 16~~ are rejected under 35 U.S.C. 102(e) as being anticipated by Shiigi (US 6,304,898).

Referring to Claim 1, Shiigi teaches a method of electronic communications comprising the steps of:

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displaying for a first user on a touch screen display of a mobile electric communication device a typewritten message that was received over a wireless connection, the text of said message having been composed by a second user (see col. 2, lines 18-33);

receiving a handwritten message image that was input by a first user using said touch screen display (see col. 2, lines 34-39); and

transmitting said handwritten message image together with said typewritten received message in the same message field to an electronic message address associated with another electronic communication device (see col. 2, lines 42-45).

Referring to Claim 15, Shiigi teaches an apparatus, comprising:

a mobile communication device including a touch screen display (see col. 2, lines 55-57) and operative to display for a first user on a touch screen display of a mobile electric communication device a typewritten message that was received over a wireless connection, the text of said message having been composed by a second user (see col. 2, lines 18-23); receive a handwritten message image that was input by said first user using said touch screen display (see col. 2, lines 34-39), and transmit said handwritten message image together with said typewritten received message in the same message field to another electronic communication device such that said handwritten message is displayed in handwritten form and said typewritten message is displayed in typewritten form (see col. 2, lines 42-45).

Referring to Claim 2, Shiigi also teaches storing a file of said transmitted handwritten image on a server (see col. 2, lines 22-23).

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Referring to Claims 5 and 16, Shiigi also teaches said mobile electronic communication device as a handheld communication device (see col. 1, lines 39-45).

Referring to Claim 6, Shiigi also teaches a wireless telephone (see col. 1, lines 39-45).

Referring to Claim 9, Shiigi also teaches a two way pager (see col. 1, lines 39-45).

Referring to Claims 3 and 4, Shiigi also teaches sizing said handwritten message image to a different size appropriate for a display size of said another communication device (see col. 3, lines 57-64).

Referring to Claims 7 and 17, Shiigi also teaches a personal digital assistant (see col. 1, lines 41-45).

Referring to Claims 8 and 18, Shiigi also teaches a Palm Handheld Computer (see col. 1, lines 41-45 where Palm Handheld Computers are one of the devices in this passage).

Referring to Claim 13, Shiigi also teaches said handwritten message transmitted via a communication network in an electronic mail format (see col. 2, lines 42-45).

### ***Response to Arguments***


4. Applicant's arguments with respect to claims 1-9, 13, and 15-18 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Eugene Yun  
Examiner  
Art Unit 2682

EY

  
LEE NGUYEN  
PRIMARY EXAMINER